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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,944	02/05/2004	John E. Kast	151P08970US02	5311

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EXAMINER
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LAYNO, CARL HERNANDZ

ART UNIT	PAPER NUMBER
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3766

MAIL DATE	DELIVERY MODE
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06/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/772,944	<b>Applicant(s)</b> KAST ET AL.	
	<b>Examiner</b> Carl H. Layno	<b>Art Unit</b> 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 11-13, 16, 18, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 6, 9, 10, 14, 15, 17 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. Acknowledgment is made of applicant's amendment, which was received by the Office on April 4, 2007.

2. Claims 1-22 are active.

#### *Oath/Declaration*

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Hence, the CORRECT STATEMENT should read "I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

INCORRECT STATEMENTS: "I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations Section 1.56(a)"

"I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56(a)"

"I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations Section 1.56"

Applicant's declaration currently reads:

"I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations Section 1.56(a)."

#### *Specification*

4. In view of the applicant's modifications to the specification and abstract, the Examiner is withdrawing the objections, which were made against the specification in the last Office action.

***Claim Objections***

5. In view of the applicant's modifications to the claims, the Examiner is withdrawing the claim objections, which were made in the last Office action.

***Claim Rejections - 35 USC § 112***

6. Although the Examiner agrees with applicant's statements regarding changes to claim 21 to overcome the 35 U.S.C 112 2<sup>nd</sup> and 6<sup>th</sup> paragraph rejections made against it in the last Office Action, the applicant's amendment to claim 21 appears to have typographical errors; consequently, the 35 U.S.C 112 2<sup>nd</sup> paragraph rejection against this claim is maintained since it still has an antecedent basis problem.

Specifically, in line 11, of claim 21, the statement "means for attaching the recharging to" has no antecedent basis and should be changed to read: "means for attaching the means for recharging to" to overcome this 112 rejection.

***Double Patenting***

7. Applicants' terminal disclaimer for US Patent 6,505,077 was received by the Office on March 19, 2007. This disclaimer was approved by the Office on April 16, 2007. Consequently, the Examiner is withdrawing the non-statutory obviousness type double patenting rejection based upon this reference.

***Claim Rejections - 35 USC § 102/103***

8. Upon further reconsideration of applicant's arguments and amendments to the claims, the Examiner is withdrawing the 35 U.S.C 102 and 35 U.S.C 103 rejections based upon the Leysieffer (US 6,154,677), Fagan Jr. (US 3,824,129), Fischell (US 3,888,260), Baumann et al (US 5,279,292), and Susset et al (US 3,667,477) patents, which were made against claims 1-22 in the last Office action.

9. Upon further review of applicant's submitted prior art, the Examiner deems the following new grounds of rejection to be proper.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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11. Claims 1-5, 7, 8, 11-13, 16, 18, 20, and 21 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schulman et al (US 6,067,474) (Applicant's previously cited prior art).

In regards to claims 1 and 21 the Schulman et al (US 6,067,474) patent, previously cited by the applicants' as prior art, describes a number of embodiments for an implantable stimulation device, in this case an implantable cochlear stimulator (ICS). One of the embodiments of this device, shown in Figs. 14A and 14B, includes a housing **162** (SP/PWR) (shown in greater detail in Fig. 17) having interior space for a speech processing (SP) and control circuitry **184**, electronics for connecting to an external recharging coil **194**, a power therapy delivery circuit **190**, and a rechargeable battery **192** (PWR) having an interior cavity. As shown in Fig. 14A, the external recharging coil **172** is shown mounted to the proximal end surface of housing **162**. It is electronically connected to the circuits within housing **162** via two feedthroughs **176**.

Although the recharging coil (shown in Fig. 14A as **172**) is not shown as being "centrally located" with respect to housing **162**, such a location would be inherent, if not obvious, in view of Figs. 1C and 2B of this same reference (Schulman et al '474), which teach that the circuitry within housing **162** and ICS **112** may be co-located in a single unit **132** (Fig. 1C) and that the recharging coil **22** may be centrally located on the housing of that unit, as shown in Fig. 2B.

In regard to claim 2, applicant's attention is directed to feedthroughs **176** (Fig. 14A – col. 16, lines 29-30).

In regard to claims 3-5, 7, and 11-13, the recharge coil **172** is "embedded within a suitable material, such as an encasing mold **174** made of silicone rubber or other suitable material, which mold is formed so as to adhere to the sides of the SP/PWR unit **162**" (col. 16, lines 32-35).

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This suitable material 174 also performs the function of applicant's "coil cover". Its adhesive properties could be considered to fulfill the role of a "housing attachment detail" or a "cover attachment detail".

In regard to claim 8, it would be obvious, if not inherent, to presume that the silicone rubber encasing mold 174 forms a hermetic seal with the housing 162, since the device of Schulman et al is designed to be implanted in the body and would, presumably, prevent body liquids from contacting the electronics within device housing 162.

In regard to claim 16, the power source 192 (Fig.17) is a rechargeable battery (col.17, lines 47-48).

In regards to claim 18, the Schulman et al housing 162 carries an additional coil 186 (Fig.17) used for sensing telemetry signals from an external microphone 134 (col.17, lines 54-57).

In regard to claim 20, the device of Schulman et al is a "neuro stimulator". Applicants' attention is directed to Abstract, line 1.

***Allowable Subject Matter***

12. Claims 6, 9, 10, 14, 15, 17, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

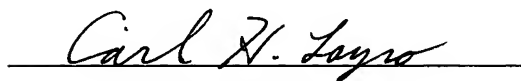
13. Claim 22 is allowed.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl H. Layno whose telephone number is (571) 272-4949. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
CARL LAYNO  
PRIMARY EXAMINER

CHL  
6/14/2007